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Paper No. 21

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OFFICE OF PETITIONS

In re Application of :
Steven MacWilliams :
Application No. 09/690,667 :
Filed: October 17, 2000 :
Attorney Docket No. 224.013US1 :
ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed December 4, 2003, to revive the above-identified application.

The petition is **DISMISSED**.

Any further petition to revive must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.137." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed;¹ (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks item (3).

A non-final Office action was mailed to the address of record on March 24, 2003, setting a three-month shortened statutory period within which to submit a reply. Since no reply was received and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the application became abandoned on June 25, 2003.

¹ In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

Petitioner states that this application was transferred from the law firm of "Schwegman, Lundberg, Woessner & Kluth" (hereinafter "Schwegman") to the current firm, "Altera Law Group" (hereinafter "Altera"), "around the time of mailing of the Office Action." In support, petitioner provides a copy of docket records for March, April, May and June of 2003, as well as a letter dated April 9, 2003 from Dena L. Reuther, an employee of Schwegman, saying, "Please find enclosed an Office Communication pertaining to the above identified matter. Our records indicate that this file was transferred to you in January of 2003."

The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 151 and 37 CFR 1.137(a). See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay. Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

According to the letter written by Dena Reuther, the application was transferred to petitioner in January of 2003, which was two (2) months prior to the mailing of the Office action. While it may be true that Schwegman did not mail the Office action to petitioner until April, it was the responsibility of petitioner to promptly submit a change of correspondence address to the USPTO when the application was transferred. Nevertheless, petitioner had ample time to notify the Office that the correspondence address for this application had changed. Moreover, a review of the application file shows that a Revocation and Power of Attorney was filed in the USPTO via certificate of mailing on May 27, 2003. Since the Revocation and Power of Attorney was filed four (4) months after the application was transferred, the late notification does not constitute unavoidable delay.

MPEP 601.04 in pertinent part states:

"Where an attorney or agent of record (applicant, if he or she is prosecuting the application *pro se*) changes his or her correspondence address, he or she is responsible for promptly notifying the U. S. Patent and Trademark Office of the new correspondence address (including ZIP code)."

MPEP 711.03(c) in pertinent part states:

"For example, where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of "unavoidable" delay will require a showing that due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address (see MPEP § 601.03), and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address."

Since petitioner did not submit a change of address for this application when the application was transferred but submitted it approximately five (5) months thereafter, the showing of record does not support a finding of unavoidable delay in accordance with 37 CFR 1.137(a) and MPEP 711.03(c). While it is obvious from the copy of petitioner's docket records that the Office action was not received, it is through no error on the part of the USPTO. Again, petitioner's failure to promptly notify the Office of the change of address for this application, which resulted in non-receipt of the Office action, does not constitute unavoidable delay.

Petitioner is strongly urged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the \$1,330 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

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The centralized facsimile number is (703) 872-9306.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

Marianne E. Morgan
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Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Examination Policy